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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/185,732	11/04/98	BARROWS	09125/01001

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HM12/0714

EXAMINER	
RUSSELL J.	
ART UNIT	PAPER NUMBER
1653	1617

DATE MAILED:

07/14/00

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☐ THE PERIOD FOR RESPONSE:

- a) ☐ is extended to run _____ or continues to run _____ from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☒ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 6-30-2000 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☒ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
 - b. ☒ They raise new issues that would require further consideration and/or search. (See Note).
 - c. ☒ They raise the issue of new matter. (See Note).
 - d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: See attachment

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☒ Upon the filing an appeal, the proposed amendment ☐ will be entered ☒ will not be entered and the status of the claims will be as follows:

Claims allowed: 1-17

Claims objected to: _____

Claims rejected: 18-162

However;

☒ Applicant's response has overcome the following rejection(s): See attachment

4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because See attachment

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other

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1. The supplemental declaration by Barrows filed October 14, 1999 (a copy of which was attached to the response filed June 30, 2000) satisfies the rejection set forth in paragraph 2 of the final Office action. As a result, claims 1-17 are now allowable.

2. Applicants did not respond to the requirement set forth in paragraph 4 of the final Office action.

3. The proposed amendment filed June 30, 2000 will not be entered because the proposed claims raise new issues under 35 U.S.C. 112, first and second paragraphs, and 35 U.S.C. 251 (new matter). The proposed claims parallel claims 18-162. However, the proposed claims parallel claims 18-162 as originally filed, before they were amended in response to the rejections under 35 U.S.C. 112, first and second paragraph, and 35 U.S.C. 251 (new matter) contained in the Office action mailed April 30, 1999. Thus, for example, proposed claim 180 has the same new matter problem with respect to the oligomeric diradical at line 14 as did originally filed claim 37, line 18. Proposed claim 180 has the same problem with respect to improper Markush language as did claim 37.

It should also be noted that proposed new claim 206 is dependent upon claim 2053. It is believed that claim 206 was intended to be dependent upon claim 205.

4. If Applicants were to submit a further amendment after final rejection correcting the problems indicated in paragraph 3 above, then proposed new claims 163-440 would be entered for purposes of appeal. Claims 163-299 would be allowable. Claims 300-440 would be rejected

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under 35 U.S.C. 251 for the same reasons set forth in paragraph 3 of the final Office action. See MPEP 1208.01 and 37 CFR 1.193(a)(2).

5. The rejection under 35 U.S.C. 251 on the basis of improper recapture is maintained for the reasons of record.

Clement at page 1165, fifth full paragraph, summarizes the recapture rule: "if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claims." Applicants argue that the comparison is to be made with claims which were canceled or amended during prosecution of the parent application. Assuming arguendo that this is the comparison to be made, instant claims 18-162 (and proposed claims 300-440) still are prohibited by the recapture rule. The examiner has pointed out four instances of surrendered subject matter which Applicants are attempting to recapture in this reissue: protein identity, protein concentration, crosslinking agent concentration, and burst strength. (At least one of these instances of surrendered subject matter is present in instant claims 18-162 and proposed claims 300-440, although not all of these instances of surrendered subject matter occur in every claim.) Concerning protein identity, the reissue claims now directed to an "albumin" protein are broader in scope than claim 2 which was canceled during prosecution of the parent application, which was directed to a "serum albumin" protein. Concerning protein concentration, crosslinking agent concentration, and burst strength, the reissue claims are now as broad as, e.g., canceled claim 1 of the parent application, i.e. neither the reissue claims nor canceled claim 1 contain any limitations with respect to protein

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concentration, crosslinking agent concentration, or burst strength. Because the reissue claims are as broad as or broader than canceled claims in at least one aspect germane to a prior art rejection, but narrower in other aspects completely unrelated to the rejection, the recapture rule bars the claims.

Applicants' attempt to distinguish Clement on the basis of the number of amendments filed in the applications is a distinction without a difference. There is no basis in the case law for limiting the recapture prohibition to those applications in which multiple amendments were filed during prosecution of the parent application. In any event, while Applicants did not file multiple amendments during prosecution of their parent application, they did file one amendment (on June 12, 1995) and a second response (on January 24, 1995) not including an amendment but again arguing that the new claim limitations distinguished over the prior art. Accordingly, the prosecution history of the instant application is deemed analogous to that occurring in Clement.

Applicants are requested to check their citation of *In re Ball*, 729 F.2d 1429 (Fed. Cir. 1984). The examiner does not have access to the F.2d reporters, and the nearest case he could locate in the USPQ reports was *Ball Corporation v. United States*, 221 USPQ 289 (Fed. Cir. 1984). It is believed that these are the same cases.

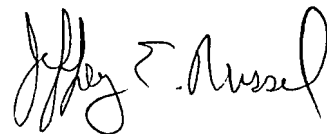
Applicants argue that they "clearly" did not surrender the subject matter concerning the protein identity, protein concentration, crosslinking agent concentration, and burst strength. However, Applicants did not provide any explanation as to why the limitations introduced into the claims during prosecution of the parent application did not constitute surrender of the subject

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matter. The limitations concerning protein identity, protein concentration, crosslinking agent concentration, and burst strength were inserted into the claims in response to a prior art rejection and were argued as a basis for distinguishing over the prior art. The inference of surrender is consistent with the analysis in Clement at page 1164, second and third full paragraph, and Applicants have pointed to no other evidence of Applicants' intent with respect to the amendments and have provided no alternative explanation for the changes. Whether recapture of the surrendered subject matter is permitted or not is, of course, a different issue from whether or not the subject matter was surrendered during prosecution of the parent application, and the permissibility of the recapture is addressed in the final Office action and elsewhere in this advisory action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey E. Russel at telephone number (703) 308-3975. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Christopher Low can be reached at (703) 308-2923. The fax number for Art Unit 1653 for formal communications is (703) 305-3014; for informal communications such as proposed amendments, the fax number (703) 305-7401 can be used. The telephone number for the Technology Center 1 receptionist is (703) 308-0196.



Jeffrey E. Russel
Primary Patent Examiner
Art Unit 1653

JRussel
July 13, 2000